

### REMARKS

Favorable reconsideration and allowance of this application are respectfully requested.

By way of the amendment instructions above, independent claims 1 and 4 have been amended so as to emphasize that the conventional surface coat includes a pigment component **consisting of** kaolin and/or calcium carbonate. Therefore, by way of such amendments, independent claims 1 and 4 necessarily now unequivocally **exclude** silica from being present in such conventional surface coat.

Applicants suggest that the amendments presented herewith, coupled with the evidence of record, clearly provide patentable distinction over the applied Kitamura reference. In this regard, the record herein is abundantly clear that such conventional surface coat composition must necessarily be silica-free as it is for gravure or flexographic printing. Thus, since Kitamura et al is directed to coating for **ink jet** printing – not gravure or flexographic printing as in the present invention – such a conventional coating must necessarily contain silica.<sup>1</sup>

The claims pending herein now require the conventional composition to be one having a pigment component which **consists of** kaolin and/or calcium carbonate as pigment(s), which language of course specifically **excludes** the presence of silica as a pigment. Thus, the present claims cover compositions having a pigment component which includes *only* kaolin, *only* calcium carbonate, or *only* kaolin and calcium

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<sup>1</sup> The Examiner's attention is again directed to the Escaffre Affidavit submitted with the applicants' response of November 6, 2001 and the remarks of record on this issue, which remarks are expressly incorporated hereinto by reference.

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carbonate. As such the conventional compositions according to the present invention are closed to the inclusion of silica.<sup>2</sup>

Therefore, since the surface coat of the present invention is a "conventional composition" which necessarily is silica-free (i.e., since the surface coat is capable of being printed by gravure or flexographic printing) and since Kitamura et al *necessarily requires* silica to be present in the surface coat (i.e., since Kitamura et al is directed to ink jet printing), the claims pending herein cannot be rendered obvious under 35 USC §103(a) based on Kitamura et al.

Withdrawal of the rejection advanced against the claims pending herein under 35 USC §103(a) based on Kitamura et al is therefore in order.

Early receipt of the Official Allowance Notice is solicited.

Respectfully submitted,

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<sup>2</sup> See, *In re Herz*, 190 USPQ 461, 463 (CCPA 1976) and *PPG Industries v. Guardian Industries*, 48 USPQ 2d 1351, 1553-54 (Fed. Cir. 1998) ("Closed claims...are written in a 'consisting of' format and fully open claims...are drafted in a 'comprising' format.")